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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/786,962	07/12/2001	Alain Rhelimi	01090/TL	8288

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EXAMINER

FUREMAN, JARED

ART UNIT

PAPER NUMBER

2876

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/786,962

Applicant(s)

RHELEMI, ALAIN

Examiner

Jared J. Fureman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 July 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: .

DETAILED ACTION

Receipt is acknowledged of the preliminary amendment and IDS, filed on 3/12/2001, both of which have been entered in the file. Claims 1-13 are pending.

Claim Objections

1. Claims 1, 3, and 5 are objected to because of the following informalities:

Claim 1, line 15: "the" (first occurrence) should be replaced with --a--, in order to avoid a lack of proper antecedent basis for "the surface".

Claim 3, line 3: "the potentials" lacks proper antecedent basis.

Claim 5:

Line 15, "the" (first occurrence) should be replaced with --a--, in order to avoid a lack of proper antecedent basis for "the surface".

Line 16, "the data" lacks proper antecedent basis.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1, 3-5, 7, 8, 10-13 are rejected under 35 U.S.C. 102(e) as being anticipated by Sarat (US 6,199,128 B1).

Sarat teaches a portable article (18) of the smart card type and a method of transmitting data to an integrated circuit chip of a portable article of the smart card type, the article comprising firstly a body (see figure 2) and secondly an integrated circuit chip, said integrated circuit chip having a central processor unit (microprocessor 24) connected via a data and address bus to memories (22), and further including at least a first contact pad (not shown) suitable for providing the chip with a power supply voltage, a second contact pad (not shown) suitable for grounding the chip, a third contact pad (not shown) and a fourth contact pad (not shown), said contact pads being electrically connected respectively to a first contact area (Vcc), a second contact area (GND), a third contact area (I/O₁), and a fourth contact area (I/O₂) of a set of eight contact areas flush with a surface of the article body, said portable article being characterized in that the third and fourth contacts pads are connected to an interface of the chip and are suitable for providing data transmission under the control of the central processor unit; the third and fourth pads constituting a differential pair, with potentials present on said pads being opposite to each other (typical of the universal serial bus standard); the third and fourth pads are suitable for transmitting data using protocols defined in the universal serial bus standard (see column 2 lines 49-52); the third and fourth contact pads constitute a differential pair; data transmission via the third and fourth pads takes place in both directions in alternation; data is transmitted via the third and fourth contact pads using a synchronous communications protocol; data transmission is provided at rates going up to a value of about 12 megabits per second (typical of the universal serial bus standard); in order transmit data via the third and fourth pads, the portable article is

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connected connector of a reader in such a manner that initially connection is made to the second contact area, then connection the third and fourth contact areas, and finally to the first contact area (see figures 2, 6, column 2 lines 31-52, column 4 lines 46-61, column 5 line 5 - column 6 line 41, column 6 line 62 - column 7 line 34).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sarat in view of Sengoku (US 5,875,321).

The teachings of Sarat have been discussed above.

Sarat fails to specifically teach that in order to process data transmitted via the third and fourth contact pads, a clock is generated internally in the chip.

Sengoku teaches that smart cards may either receive an external clock signal or generate a clock signal internally (see column 1 lines 40-45).

In view of Sengoku's teachings, it would have been obvious to one of ordinary skill in the art at the time of the invention to include, with the card and method as taught by Sarat, that in order to process data transmitted via the third and fourth contact pads, a clock is generated internally in the chip, in order to further simplify the card reader/adapter by not requiring the reader/adapter to provide a clock signal to the card.

Allowable Subject Matter

6. Claims 2 and 6 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

7. The following is a statement of reasons for the indication of allowable subject matter: The prior art of record, taken alone or in combination, fails to teach or fairly suggest: a smart card having third and fourth contact areas/pads for providing data transmission under control of the central processor and an eight contact area/pad suitable for inputting and outputting data signals using an asynchronous protocol, in combination with the other claimed limitations as set forth in the claims.

While smart cards conforming to the ISO 7816 protocol include a contact/pad for inputting and outputting data signals, they do not utilize third and fourth contact areas/pads for providing data transmission under control of the central processor.

Sarat teaches a smart card that can operate according to the ISO 7816 protocol and according to other non-ISO protocols, such as PS/2 or USB protocols (see column 2 lines 31-52). However, Sarat teaches using the already existing input/output pin for both ISO protocols and non-ISO protocols, and simply utilizing one extra input/output pin for non-ISO protocols (for example, I/O₁ would be used by itself for ISO protocols, and I/O₁ and I/O₂ would be used for non-ISO protocols). Thus, following Sarat's teachings, if one of ordinary skill in the art at the time of the invention were to combine the teachings of Sarat with a standard ISO 7816 compliant smart card, there would only be two input/output contacts/pads, not three as claimed by the present invention.

Therefore, without the benefit of applicant's teachings, there is no motivation for one of ordinary skill in the art at the time of the invention to combine the teachings of the prior art of record in a manner so as to create the claimed invention.

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Sarat (US 6,151,647), Leydier et al (US 2002/0066791 A1), Fruhauf et al (US 6,439,464 B1), Leydier et al (US 6,343,364 B1), Sarat (US 6,581,122 B1), Leydier et al (US 6,543,690), Guion et al (US 2003/0155424 A1), Gray (US 2003/0085287 A1), Okubo (JP 62-224874 A) all teach smart cards and methods of communicating data with smart cards.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jared J. Fureman whose telephone number is (703) 305-0424. The examiner can normally be reached on 7:00 am - 4:30 PM M-T, and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

August 25, 2003

Jared J. Fureman
Jared J. Fureman
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